

Prouty, Rebecca

From: Prouty, Rebecca
Sent: Friday, July 06, 2007 1:45 PM
To: Kisliuk, Bruce
Subject: RE: 10/791,799

Sorry I was confusing and partially incorrect in what I said regarding the case the ODP is over. Current case is a CIP of the case I did ODP over not a divisional. These cases relate to two different enzymes. I originally made a restriction between protein, DNA and methods of use. In one of the cases they elected the enzyme and I issued claims to the enzyme and variants thereof having at least 85% identity thereto and activity. However this case I could likely argue is distinct as it claims the other enzyme from the one at issue in the current case. In second case in the series they elected the method group (which included use of both enzymes). In the final claims which issued only 2 of the claims recite methods use of the same enzyme as in the current case. In the current case they also presented claims to methods of use of both enzymes which in this case I restricted between. The ODP rejection is over only the claims of the patent reciting the same enzyme as claimed in this case. The claims in the two cases differ in a few respects (thus they are ODP and not statutory DP) but not in the scope of the enzyme recited in the methods and applicants are specifically pointing this out in their arguments. I hope this is clearer. Becky

-----Original Message-----

From: Kisliuk, Bruce
Sent: Friday, July 06, 2007 1:12 PM
To: Prouty, Rebecca
Subject: RE: 10/791,799

Kinda hard to follow, but if we made a restriction between groups of claims, and they file a divisional based on our restriction requirement and the scope of the claims haven't changed from the restriction, cannot make an ODP on those claims - it's statutorily prohibited and can't be waived.

If the claims are of different scope, could make an ODP but would need to make clearly on the record our interpretation of the difference in claim scope versus the claims that were subject to restriction.

If you are just making a rejection (not ODP) of pending claims that may cast a shadow on the patentability of issued claims, not a problem.

If the ODP is not an issue, have it brought to me Monday am and I will sign.

-----Original Message-----

From: Prouty, Rebecca
Sent: Friday, July 06, 2007 12:20 PM
To: Kisliuk, Bruce
Subject: 10/791,799

Bruce- I need to get your signature on the attached Office Action. The instant case is a divisional of two parent applications which are both issued. I am rejecting claims reciting 85% identity to SEQ ID NO:11 in the instant case reciting methods when I allowed this scope in the parent cases when the claims were to the enzyme or nucleic acids. I no longer feel that this scope is enabled but as applicants are arguing that it is the same scope as previously allowed and there is a double patenting rejection over some method claims in one of the parent patents I think the action should have your signature. Since today is my work-at home day I can't bring the action to you and it is an amended due on Monday (note if you can't get to it before then I will talk to Murthy about it Monday). I have also posted the Action to you in OACS. If you have any questions you can e-mail me or call me at 703-568-1340. Becky

<< File: Final Rejection.doc >>